

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB

DEC. 23, 98

Hearing:
March 18, 1998

Paper No. 19
SIMMS/md

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Astra Merck Inc.

Serial No. 74/581,133

Glenn A. Gundersen of Dechert, Price & Rhoads for Astra
Merck Inc.

Hannah Fisher, Trademark Examining Attorney, Law Office 107
(Thomas Lamone, Managing Attorney)

Before Simms, Hairston and Walters, Administrative
Trademark Judges.

Opinion by Simms, Administrative Trademark Judge:

Astra Merck Inc. has appealed from the final refusal
to register the mark show below



for goods described as "a full line of pharmaceuticals" in Class 5.¹ After the statement of use was filed in this case, the Examining Attorney refused registration for the following reason:

Applicant's evidence is insufficient to support use of the mark on a full line of products. TMEP 804.03(a).
Applicant's attorney states that the mark is used only on the three drugs for which labels were submitted.
Applicant cannot use the full line/house mark description of goods in an effort to avoid future filings.
However, applicant is entitled to amend the description of goods to reflect current use. This course of action can be expedited by examiner amendment.

¹ Application Serial No. 74/581,133, filed August 24, 1994. The original application was filed by Merck & Co., Inc. (d/b/a Astra/Merck Group), a New Jersey corporation. The current applicant is the owner of this mark by assignment and change of name. In the application, it is indicated that the drawing is lined for the colors purple and yellow. The original application was filed on the basis of applicant's bona fide intention to use the mark in commerce. After the mark was published for opposition, applicant submitted a statement of use. In the statement of use, applicant asserts use in commerce at least as early as January 23, 1995.

See Priority Action, issued May 23, 1996. The Examining Attorney eventually issued a final requirement for an amended description of goods:

The Manual limits registrations for house marks to those circumstances in which broad use of the mark is demonstrated through catalogues or similar evidence. Use of the mark on three products does not fulfill this requirement.

See Final Refusal issued October 9, 1996. Applicant and the Examining Attorney have submitted briefs and an oral hearing was held.

It is applicant's position that it should not be required to delete the current description of goods and to specify the particular pharmaceutical products on which its mark is used. Applicant notes that it has submitted labels showing use of the asserted mark on all three of the pharmaceutical products which it markets (under the marks PRILOSEC, PLENDIL and TONOCARD). (Applicant notes that, since the date of filing of the statement of use, it has begun marketing a fourth pharmaceutical product under the mark LEXXEL.) Applicant argues that the Trademark Manual does not require a minimum number of products "for house mark status," nor does it require that a mark appear on every conceivable type of pharmaceutical product in order to be considered a house mark.

If an applicant demonstrates that all of its different pharmaceutical products bear a particular mark in common, then that mark is obviously functioning as a house mark for that product line, regardless of the exact number of products in that product line. To hold the opposite, as the examining attorney has done, is to favor large companies with large product lines and to penalize smaller companies or companies with smaller product lines. This is obviously an inequitable result... Small companies should be eligible for house mark registration as long as they have multiple products in their product line and they use the mark throughout the product line.

Applicant's appeal brief, 2.

In her appeal brief, the Examining Attorney argues that, in order to permit registration with such a description as applicant has here ("a full line of pharmaceuticals"), applicant must provide support showing such broad use of the mark or "similar evidence to substantiate the claim of use as a house mark." Examining Attorney's brief, 2. Greater specificity is required, according to the Examining Attorney, when an applicant has identified its goods very broadly but does not use the mark on a "substantial" number of goods encompassed by the identification. "Precedent demonstrates that the above evidence is insufficient to establish use as a house

mark...[I]nequity exists where an applicant receives rights to a broad identification of goods, if it only uses a mark on a few items." Examining Attorney's appeal brief, 3.

We affirm the refusal of registration. First, however, we believe that this appeal has been needlessly complicated by arguments of the attorneys with respect to whether or not applicant's mark is a house mark. That issue is irrelevant to our determination. Part of this confusion may be caused by Section 804.03(a) of the Trademark Manual of Examining Procedure. That Section provides, in part:

Under certain limited circumstances, an applicant may apply to register a mark as a house mark. In the case of applications for house marks, the Office has permitted and will permit the use of somewhat broader terms than might otherwise be accepted in an identification of goods. In such a case, the identification of goods may include wording such as "a house mark for..." or "a full line of..." All such applications must define the type of goods with sufficient particularity to permit proper classification and to enable the Office to make necessary determinations under Trademark Act § 2(d), 15 U.S.C. § 1052(d).

In an application to register a mark as a house mark based on use in commerce, the Office requires that the applicant demonstrate that the mark is, in fact, used as a house mark, in addition to requiring the usual specimens of use.

The examining attorney should require that the applicant provide catalogues showing broad use of the mark or similar evidence to substantiate this claim.

Likewise, an intent-to-use applicant who wishes to register a mark as a house mark must clearly indicate its intention to register the mark as a house mark during initial examination, and the circumstances must establish that the applicant's proposed use of the mark as a house mark is credible. The nature of the mark and the capacity of the applicant to use the mark as asserted should be considered in determining whether the claim that the mark is to be used as house mark is credible. If the applicant indicates such an intention, the examining attorney should also advise the applicant that, upon filing of the amendment to allege use or the statement of use, the applicant will be required to provide evidence to substantiate use as a house mark. If the applicant cannot do so, the applicant will be required to amend the identification of goods to conform to the usual standards for specificity.²

It appears that both applicant's attorney and the Examining Attorney have focused, in their briefs and at the oral hearing, on whether or not the asserted mark functions as a house mark. Because applicant consistently uses its mark on each and every one of its pharmaceuticals, the

² In this case, the Examining Attorney approved the intent-to-use application for publication but did not advise applicant that it will have to provide evidence of "broad use of the mark" upon the filing of the statement of use, as indicated in this section of the Manual.

asserted mark is, by definition, a house mark. However, the critical inquiry in this case is whether an applicant, who applies its mark to only three pharmaceutical products, should be able to register this mark for a description which states "a full line of pharmaceuticals." We do not believe that an applicant should.

Although this record is devoid of evidence relating to the pharmaceutical industry, a casual review of the Physicians' Desk Reference (1995) and other PDR publications, of which we take judicial notice, reveals that there are literally thousands of prescription and non-prescription drugs. The variety and scope of pharmaceutical products is astounding.

The TMEP does not indicate (nor should it) the minimum number of goods or services required in order for an applicant to register a mark for a full line of those goods or services. Suffice it to say that an application to register a mark for a full line of pharmaceuticals based upon use on only three products does not justify such a broad description.³

³ While the TMEP does not specifically note the reason for this practice, it is clear that the policy derives from the theory that an applicant who does not in fact use a particular mark on a sufficient number or variety of goods or services in its line, should not be able to procure a registration which potentially

Decision: The requirement of the Examining Attorney
for a revised description of goods is affirmed.

R. L. Simms

P. T. Hairston

C. E. Walters
Administrative Trademark
Judges, Trademark Trial and
Appeal Board

may bar the registration of another applicant who uses a similar mark on different products. In this case, for example, applicant, who according to counsel's statements at the oral hearing, is using its asserted mark on a gastrointestinal drug, a cardiovascular drug and a drug to treat hypertension, who obtains a registration for "a full line of pharmaceuticals" but is only using its mark on a very few, could conceivably prevent the registration of a similar mark for a completely unrelated pharmaceutical product.